

REMARKS/ARGUMENTS

Claims 2 and 4-6 are currently pending and are presently amended. No new matter has been added.

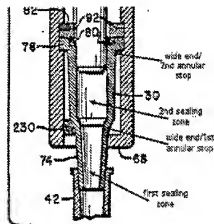
Regarding the rejection of Claims 2 and 4-6 under 35 USC 112, second paragraph, the Examiner states that the “claim recitations either appear to be reciting both of the pipette tips are [simultaneously] engaged on the mounting shaft which is not possible or the “alternative” language requires one tip to be engaged at a time.”

Definiteness of claim language must be analyzed in light of the specification and the prior art as one of ordinary skill in the art would understand the claims. *In re Angstadt*, 537 F.2d 498, 190 USPQ 214, 217 (C.C.P.A. 1976). Clearly a person of ordinary skill in the art of pipette would not understand the subject matter of a claim to be one that the Examiner admits is mechanically “not possible” and is clearly contrary to the prior art and the object of the invention as is clearly understood from the specification; therefore a person of ordinary in the art would clearly understand the claims to require one pipette tip at a time to be engaged on a pipette tip mounting shaft as is taught in the prior art and the Applicants’ specification, especially Figs. 2 and 3. “Only when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite.” *Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1366, 71 USPQ2d 1081, 1089 (Fed. Cir. 2004). Indeed, “if the language used by applicant satisfies the statutory requirements of 35 U.S.C. 112, second paragraph, but the examiner merely wants the applicant to improve the clarity or precision of the language used, the claim must *not* be rejected under 35 U.S.C. 112,

second paragraph, rather, the examiner should suggest improved language to the applicant.” MPEP §2173.02 (8<sup>th</sup> ed. 2001, last revised July 2008).

Applicants therefore respectfully assert that the indefiniteness rejection is improper as the Examiner has not made a prima facie case under 35 USC 112, second paragraph that the claims as earlier presented are indefinite; nonetheless, Applicants presently amend the claims because Applicants do not regard the scope of the claims to be narrowed by adding “one at a time of” to Claims 2 and 4, and “when not engaged with a pipette tip of a first or second diameter” to Claims 5 and 6.

Regarding the rejection of Claims 4 and 6 under 35 U.S.C. §102(b) over Yonkers (US Patent No. 4,599,220), and the rejection of Claims 2 and 5 under U.S.C. §103(a) over Yonkers, independent Claims 2 and 4 each call for a second *annular* pipette stop. In contrast, the structure of Yonkers



that Examiner views as the “wide end/2<sup>nd</sup> annular stop” is a lower surface of plate 78. The outer periphery of plate 78 is rectangular (as clearly shown in the exploded view of Fig. 2), therefore the lower surface of plate 78 of Yonkers that Examiner regards as the second pipette stop is *not* annular as called for by Claims 2 and 4.

The annular feature of the stops called for by Applicants’ Claims 2 and 4 allow the pipette tip ejector to move axially such that the striker portion moves distally past the first and second annular stops, thereby ejecting a pipette tip regardless of whether it is engaged with the first or second sealing zone. This is not possible for the Yonkers device

because the rectangular plate 78 does not allow foot 230 to retract above or to move axially past plate 78 (which Examiner regards as the “wide end/2<sup>nd</sup> annular stop”). Therefore, on the basis of this recitation alone Claims 2 and 4 and Claims 5 and 6 that depend therefrom are novel and non-obvious over Yonkers.

Additionally regarding Claims 2 and 5, Claim 2 as presently amended calls for:

a pipette tip ejector having a striker portion for striking the upper edge of the pipette tip, the ejector axially movable between a proximal retracted position and a distal ejecting position, *the striker portion positioned axially proximal of the first and second annular pipette tip stops in the retracted position and positioned axially distal of the first and second annular pipette tip stops in the ejecting position* (emphasis added).

As shown in Applicants’ Fig. 2 and as is described at least in ¶¶ [0009] and [0016], Applicants’ pipette tip ejector 3 “is axially moveable downward [distally] ...from the position shown past first annular pipette tip stop 5” (¶ [0009]) in order to eject the pipette tip 20 or 21. The position from which the ejector is moved, the “proximal retracted position”, positions the striker portion of the ejector proximal [above] the first and the second annular pipette tip stops 5 and 7.

In contrast to Applicants’ claimed invention, Yonkers discloses a foot (striker portion) 230 of stripper plate (ejector) 40 shown in Fig. 2 (exploded view), and also shown in Fig. 3 (foot 230 shown in the proximal retracted position) and in Fig. 6 (foot 230 shown in the distal ejecting position), that is clearly not capable of being moved proximal (above) what the Examiner regards as the “wide end/1<sup>st</sup> annular stop” or the “wide end/2<sup>nd</sup> annular stop” of the pipette tip mounting shaft according to Yonkers.

More specifically, as can be understood at least from Fig. 3, foot 230 engages against the “wide end/1<sup>st</sup> annular stop” and therefore can not be axially moved to a position *proximal of the first and second annular pipette tip stops* as called for by

Applicants' amended Claim 2. This limitation of the device disclosed by Yonkers can also be appreciated by viewing the structure of foot 230 and plate 78 (which is structure that Examiner regards as the "wide end/2<sup>nd</sup> annular stop"). Therefore, on the basis of this recitation of Claim 2 alone, Claim 2 and Claim 5 that depends therefrom are novel and non-obvious over Yonkers.

Additionally, regarding Claims 4 and 6, Claim 4 as presently amended calls for:

a pipette tip ejector having a striker portion arranged for striking the upper edge of the one of the pipette tips of a first and second diameter engaged to the pipette tip mounting shaft, the ejector axially movable from a proximal retracted position to a distal ejecting position by which the striker portion strikes the upper edge of the pipette tip thereby axially ejecting it from the pipette tip mounting shaft.

In contrast to Applicants' claimed invention, Yonkers disclose a foot (striker portion) 230 of stripper plate (ejector) 40 that is not arranged for striking the upper edge of a pipette tip of a second diameter as called for by amended Claim 4. More specifically, as can be understood at least from Fig. 3, foot 230 engages against the "wide end/1<sup>st</sup> annular stop" and therefore is not axially movable to a distal ejecting position by which the striker portion strikes the upper edge of the pipette tip thereby axially ejecting it from the pipette tip mounting shaft. Thus, Yonkers does not disclose or suggest Applicants' invention as called for by amended Claim 4. In fact, as arranged by Yonkers, foot 230 is not capable of striking the upper edge of a pipette tip of a second diameter (which as called for is engaged with the second sealing zone) because foot 230 is only movable from a position distal of the second sealing zone (shown in Fig. 3) to a position distal of the first sealing zone (shown in Fig. 6). Therefore, on the basis of this recitation alone of Claim 4, Claim 4 and Claim 6 that depends therefrom are novel and non-obvious over Yonkers.

Applicants submit that the application is in condition for allowance and timely examination to that end is respectfully requested. Should the Examiner have any further questions regarding any of the foregoing, the Examiner is respectfully invited to telephone the undersigned at (317) 891-1500.

Respectfully submitted,

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